

Claims 24 and 25 are in the case, neither of which is allowed.

Restriction

The Examiner has required that the case be restricted under 35 U.S.C. 121 to claims 17-22 of Group I, or claims 24 and 25 of group II.

Applicants elect Group II claims with traversal, and request that this restriction requirement be reconsidered and withdrawn.

Applicants' attorney has filed and prosecuted to issuance many cases in recent years which include both method and related Beauregard (program storage device) claims, with identical steps, differing only in the preamble. This is the first case in his experience in which such restriction has been required. Clearly, such a restriction requirement does not represent proper examination practice, and for good reason.

For example, the Examiner asserts as follows:

"Inventions I. and II. are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Invention I can be carried out, at least in part, by hand. For example the assessing of the database could be carried out manually or in a person's mind."

Applicants submit that clearly key elements of the invention cannot be practiced "by hand". The Examiner states that the claim of Invention I can be carried out "at least in part" by hand, and suggests that the assessing step could be carried out manually or in a person's mind. This "mental steps" argument has long been discredited when raised in the context of 35 U.S.C. 101. (See Ex Parte Nassim, Appeal No. 91-2486 (B.P.A.I. 1991) (unpublished).) In the context of the present application, to assert that such a complicated invention could be practiced "in a person's mind" is clearly wrong.

The Examiner asserts that the search required for Group I is not required for Group II. Applicants disagree. The subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. Claims 17 (Group I.) and 24 (Group II.) ARE IDENTICAL, EXCEPT ONLY IN THE PREAMBLE. Claim 17 recites "A method... comprising the steps of:" and Claim 24 "A program storage device... said method steps comprising:". The method steps in each are (at least were before the present amendment to claim 24) identical. Thus, Applicants respectfully submit that the search and the examination of the entire application could be made without serious burden. See MPEP Section 803, in which it is stated that "if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits" (Emphasis added). Applicants respectfully submit that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicate examination by the U.S. Patent and Trademark Office.

Applicants urge that the restriction requirement be withdrawn, and claims 17-22 also be examined in the present

application.

Double Patenting

Claims 24 and 25 have been rejected under the judicially created doctrine of obviousness-type double patenting over corresponding claims of Applications No. 09/444,253; 09/444,255; 09/444,256; and 09/444,257.

In order to further prosecution, applicants submit herewith terminal disclaimers complying with 37 C.F.R. 3.73(b), and request that this rejection of claims 24 and 25 now be withdrawn.

35 U.S.C. 112

Claims 24 and 25 have been rejected under 35 U.S.C. 112, second paragraph.

The Examiner states that the claims contained "functional recitations which fail... to add any structural limitations to the claimed storage device."

Applicants claims 24 and 25 are not drawn to the structure of a storage device, but rather as follows:

"A program storage device readable by a machine, tangibly embodying a program of instructions executable by a machine to perform method steps for coordinating a project for designing, implementing, and using a general procurement and accounts payable (GP/AP) system for a customer, said method steps comprising:..."

Thus, the recitations in the body of the claims are drawn to limit the method steps which are executed by a machine, and not, at least primarily, to the structural limitations of a storage device.

The Examiner further states:

"A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." (Office Action, pages 6-7).

The Examiner has not specified the prior art which is capable of performing applicants' claimed use. However, applicants note, this rejection under 35 U.S.C. 112 is not a rejection on art. Consequently, applicants are left unable to respond by presenting a structural difference with respect to art which under 35 U.S.C. 112 is not specified by the Examiner. Notwithstanding this, applicants have amended claims 24 and 25 to more clearly define the method steps executed by the machine and thus, in a certain and adequate sense, the "structure" of the storage device.

Applicants request that the rejection of claims 24 and 25 under 35 U.S.C. 112 be withdrawn, and that these claims be allowed.

35 U.S.C. 103

Claims 24 and 25 have been rejected under 35 J.S.C. 103(a) over Gundewar et al. (U. S. Patent 6,381,610).

Gundewar describes a method for automated project planning based on templates (col. 1, lines 49-55) and associated work flow (figure 4).

The Examiner asserts that:

"Gundewar discloses a system and method for coordinating a project capable of maintaining a database of templates with user terminals accessible via a server." (Office Action, page 7).

However, the Examiner fails to specify where in Gundewar there is any suggestion of the steps explicitly recited in applicants claims. In particular, there is no teaching in Gundewar that project planning includes such processes as business controls, transformation management, accounting, customization, feedback management, problem resolution. Thus, the Examiner's assertion that --

"Code instructions are inherent to computer systems. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use computer code instructions in the system of Gundewar in order to enable the system to automatically carry out the disclosed method." (Office Action, page 7)

-- may speak to the method disclosed in Gundewar but does not speak to applicants' method. Applicants claim a method

that includes the several steps discussed above not taught by Gundewar. The Examiner's statement says, in improper effect, that code instructions inherent in computer systems make it obvious for Gundewar to teach by way of his specific method any method, including those which are not taught by Gundewar. Gundewar's method could only have been applied to applicants claims through impermissible hindsight reasoning. ←

Applicants request that the rejection of claims 24 and 25 under 35 U.S.C. 103 be withdrawn.

SUMMARY AND CONCLUSION

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attachment is captioned "**Version with markings to show changes made.**"

Applicants urge that the above amendments be entered and the case passed to issue with claims 24 and 25.

A previous Examiner found allowable subject matter in this application. In response to a second examination

rejecting the allowed claim(s), applicants have already found it necessary to file a continuation. Therefore, applicants' attorney requests that if, in the judgement of the Examiner, this amendment does not place the case in condition for allowance, that she or her supervisor contact him to see if a way can be found to resolve any remaining issues.

Sincerely,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Claims 17-22 have been canceled, without prejudice and with traversal.

Claims 24 and 25 have been amended as follows:

1 24. [Twice amended] A program storage device readable by a
2 machine, tangibly embodying a program of instructions
3 executable by a machine to perform method steps for
4 coordinating a project for designing, implementing, and
5 using a general procurement and accounts payable (GP/AP)
6 system for a customer, said method steps comprising:

7 maintaining a database of templates describing a
8 plurality of task templates including summary tasks and
9 detail tasks; [for]

10 analyzing and adapting a legacy application to provide
11 an adapted application including said summary tasks and
12 detail tasks customized to said customer;

13 operating a plurality of web-enabled user terminals to
14 access via a server said database; [for]

15 coordinating tasks by a plurality of enterprise and
16 customer teams throughout project implementation phases
17 including assessing, preparing, developing, deploying
18 and supporting phases;

19 in said assessing phase [accessing said database of
20 templates for] defining in said database of templates
21 for said customer an integrated, cross-functional
22 customer solution including technical, educational, and
23 human resource;

24 in said preparing phase [accessing said database of
25 templates for] initializing said project and modeling a
26 plan in said database of templates for making a
27 transition from said customer legacy to said adapted
28 application;

29 in said developing phase [for] documenting in said
30 database of templates business controls, transformation
31 management, accounting, and requisition and catalog
32 application customization required for said adapted

33 application;

34 in said deploying phase [accessing said database of
35 templates for] deploying quality, transition
36 management, and integrated project management systems
37 and procedures for said customer;

38 in said supporting phase [accessing said database of
39 templates for] providing communication of feedback,
40 real time application assistance, and special requests
41 for problems concerning data; and

42 providing at said server a first user interface
43 template for designing said summary tasks, a second
44 user interface template for designing said detailed
45 tasks, and a third user interface template selectively
46 for selecting [or] and creating said summary and
47 detailed tasks.

1 25. [Amended] The program storage device of claim 24, said
2 method further comprising
3 providing in said first and second templates

4 [providing] selectively [either] directly [or] and by
5 way of links to other documents, instructions, flow
6 charts, sample questionnaires, report models and
7 checklists for guiding, coordinating and documenting
8 the work of a plurality of said enterprise and customer
9 teams; [through steps for]

10 confirming and refining project management standards
11 and procedures, including an issue management plan,
12 project documentation, and quality assurance
13 standards[,] ; and

14 creating a team building plan.